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EXAMINER

GORT, ELAINE L

ART UNIT PAPER NUMBER

3627

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/588,534

Applicant(s)

JOHNSON ET AL.

Examiner

Elaine Gort

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005 and 01 February 0206.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3-10 is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchbanks et al. (US Patent 6,266,401) in view of Heindel et al. (US Patent 6,304,857) and Examiner's Official Notice.**

Marchbanks et al. discloses the claimed method of verifying taxes on a batch of customer bills but is silent regarding utilization of an outsourced billing entity (3<sup>rd</sup> party) to generate "hold" bills and to carry out the final distribution of bills; the specific step of performing a recalculation for verification purposes; and the displaying of worksheet information.

Heindel et al. discloses that it is known in the art to provide outsourced billing utilizing a network to have another company assist in the preparation of bills ("hold bills") such as to provide final distribution of bills in order to reduce costs and/or resources required for billing (see abstract and figures 1-5).

Examiner takes Official Notice that it is notoriously old and well known in the art of verification to perform a recalculation in much the same way as the initial calculation to determine if the first calculation is accurate.

Examiner takes Official Notice that it is notoriously old and well known in the art of data processing to display database information in the form of a worksheet on a computer monitor to provide users the ability to view and manipulate data within the database.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of verifying taxes of Marchbanks et al. with the outsourcing for assistance in generating and distributing bills as taught by Heindel et al. in order to reduce costs and resources required for billing.

It further would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of verifying taxes of Marchbanks et al. and Heindel et al., as modified above, with the performance of a recalculation and the display of data in the form of a worksheet as taught by Examiner's Official Notice in order to determine if the initial tax calculation is correct and to provide the ability to view and manipulate data within the database, respectively.

Note for clarification: in this modified scenario of above, the third party carries out the generation of the "hold" bill and waits for the verification, which is done by the telecommunications service provider, and after verification is completed the 3<sup>rd</sup> party would then do the final distribution of the bills (i.e. the telecom provider is only outsourcing the generation of the hold bill and the distribution of the verified bills, not the verification of the taxes on the bills).

***For clarification of the rejection the following explanation is provided:***

A method of verifying hold bill taxes on account charges on a customer hold bill, the hold bill being a bill that is scheduled to be sent as a customer bill to a customer by a first entity on behalf of a second entity, the first entity having independently calculated the hold bill taxes (Marchbanks discloses the method of generating invoices including an initial tax calculation which is then verified for accuracy and once verified then printed for final production, see column 4 lines 41+; The Examiner has used Official Notice to outsource only the steps of generating the invoices including an initial tax calculation and the final distribution of bills, therefore the telecom provider maintains the verification of tax step), comprising the steps of:

(Regarding claim 11) maintaining a tax rate database in communication with a data network (Marchbanks, such as shown in figures 16A-G, discloses the use of tax data which inherently must be obtained from a database in order to be entered into a bill);

maintaining a second database that includes account charges (data used in the bills as shown in Marchbanks figures 16A-G includes account charges which inherently must be obtained from a database in order to be entered into the bill. If it is found that Marchbanks does not disclose different databases for storing tax data and account charges, Examiner takes Official Notice that it is old and well known in the art of data systems to store data by category in different databases in order to keep the data separate for maintenance and access purposes.);

automatically applying the tax rate information to the account charges and storing a calculated tax result, the calculated tax result being independently calculated by the

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second entity (or "service provider" as referred to above) (the telecom provider in recalculating, as modified above by Examiner's official notice, would apply the tax requirements to the charges in order to verify the tax due);

receiving entry of an account number into a worksheet being displayed and automatically filling the worksheet with the calculated tax result on a computer that is in communication with the data network (Marchbanks inherently receives an entry of the account number when the invoice data is verified; Examiner took official notice that it is old and well known to use a worksheets to display data allow users the ability to view and manipulate data; when the telecom provider receives the billing data for verification the account number would be included with the account information);

comparing the calculated tax result displayed in the worksheet with the hold bill taxes appearing on the hold bill (Examiner took official notice of recalculating to verify accuracy, the recalculated amount is then compared to the initial calculation and if equal then the hold bill is verified; Marchbanks is silent on precisely what steps are carried out to verify taxes on the hold bills but states they are verified);

when the calculated tax result displayed in the worksheet matches the hold bill taxes, the second entity authorizing the first entity to print and to send the hold bill as a customer bill (Marchbanks discloses that after the accuracy of the hold bills are verified the invoices are printed and distributed in column 4 lines 49+; in this scenario when the recalculated value by the service provider is found to match the 3<sup>rd</sup> parties value the printing of the invoices is authorized);

(Regarding claim 12) where the step of maintaining the database includes downloading account information from a mainframe computer (Examiner takes official notice that the use of mainframe computers for obtaining data from is notoriously old and well known in the art of computer systems to provide simultaneous support to many users connected to the computer by terminals. Therefore it would have been obvious to one of ordinary skill in the art to maintain account information and other billing data on a mainframe computer to provide simultaneous support to many users connected to the computer system);

(Regarding claim 13) where the account information includes pre-bill and demand print data (the account information of Marchbanks includes usage data which is data used for the preparing and printing of bills, for example see data used in figures 16A-G);

(Regarding claim 14) further comprising supplying the tax rate information to the mainframe computer (Examiner has takes official notice that the use of mainframe computers for obtaining data from is notoriously old and well known in the art of computer systems to provide simultaneous support to many users connected to the computer by terminals. Therefore it would have been obvious to one of ordinary skill in the art to maintain account information and other billing data such as tax rate information on a mainframe computer to provide simultaneous support to many users connected to the computer system. Therefore it would have been necessary to supply tax rate information to the mainframe computer in order for it to provide it);

(Regarding claim 15) further comprising scanning the hold bill and storing an image thereof (Examiner takes official notice that the use of scanning and character recognition of printed matter is notoriously old and well known in the art of computer systems to provide an electronic copy of the document and also the ability to determine which alphanumeric characters or punctuation marks the shapes represent. Therefore it would have been obvious to one of ordinary skill in the art to scan in printed copies of the "hold" bills generated by the 3<sup>rd</sup> party and to use character recognition as taught by Examiner's Official Notice in order to provide an electronic copy of the printed bill with the ability to determine what the invoices contain for verification against the service providers recalculated tax value.);

(Regarding claim 16) further comprising applying optical character recognition software to the image and storing a file representative of characters obtained (Examiner has taken official notice that the use of scanning and character recognition of printed matter is notoriously old and well known in the art of computer systems to provide an electronic copy of the document and also the ability to determine which alphanumeric characters or punctuation marks the shapes represent. Therefore it would have been obvious to one of ordinary skill in the art to scan in printed copies of the "hold" bills generated by the 3<sup>rd</sup> party and to use character recognition as taught by Examiner's Official Notice in order to provide an electronic copy of the printed bill with the ability to determine what the invoices contain for verification against the service providers recalculated tax value.);



(Regarding claim 17) further comprising electronically comparing at least a portion of the file with the calculated tax result (Examiner has taken official notice that the use of scanning and character recognition of printed matter is notoriously old and well known in the art of computer systems to provide an electronic copy of the document and also the ability to determine which alphanumeric characters or punctuation marks the shapes represent. Therefore it would have been obvious to one of ordinary skill in the art to scan in printed copies of the "hold" bills generated by the 3<sup>rd</sup> party and to use character recognition as taught by Examiner's Official Notice in order to provide an electronic copy of the printed bill with the ability to determine what the invoices contain for verification against the service providers recalculated tax value.);

(Regarding claim 18) where the database is in communication with a local server (Both Marchbanks and Heindel disclose the use of networked systems to share and transfer data; in this modified scenario the billing data used by the 1<sup>st</sup> entity to prepare the prevalidated bill would use the same billing data that the 2<sup>nd</sup> entity (or service provider) would use to recalculate for verification purposes. This data would be shared over a network and is accessible by the use of servers.);

(Regarding claim 19) further comprising using the calculated tax result to identify errors on the hold bill (Marchbanks discloses that after the accuracy of the hold bills are verified the invoices are printed and distributed in column 4 lines 49+; in this scenario when the recalculated value by the service provider is found to not match the 3<sup>rd</sup> parties value an error is identified and the bill is not approved for distribution);

(Regarding claim 20) A method of verifying the accuracy of tax charges on a hold bill generated for a customer account by an outsourced entity, the hold bill being one that is scheduled to be sent directly to the customer by the outsourced entity as a customer bill upon verification, by an entity providing service, other than billing service, (Marchbanks discloses the method of generating invoices including an initial tax calculation which is then verified for accuracy and once verified then printed for final production, see column 4 lines 41+; The Examiner has used Official Notice to outsource only the steps of generating the invoices including an initial tax calculation and the final distribution of bills, therefore the telecom provider maintains the verification of tax step), the method comprising the steps of:

downloading data, including customer charges, to the entity providing service, other than billing service to a local server (the service provider in the modified scenario would download account data and tax data to perform a recalculation for verification purposes);

on the local server, automatically determining which customer charges are subject to taxation (the service provider in the modified scenario would download account data and tax data to perform a recalculation for verification purposes and would determine which charges are subject to taxation, for example see figures 16A-G illustrating different tax categories);

on the local server, automatically calculating the tax for the customer charges subject to taxation and storing calculated tax results (the service provider in the

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modified scenario would download account data and tax data to perform a recalculation for verification purposes);

receiving entry of an account number in a worksheet being displayed and automatically filling the worksheet with the calculated tax results on a user computer (Marchbanks inherently receives an entry of the account number when the invoice data is accessed to be verified; Examiner took official notice that it is old and well known to use worksheets to display data to allow users the ability to view and manipulate data; When the telecom provider receives the billing data for verification the account number would be included with the account information.);

on the local server, comparing the calculated tax results displayed in the worksheet to the tax charges on the hold bill (Examiner took official notice of recalculating to verify accuracy, the recalculated amount is then compared to the initial calculation and if equal then the hold bill is verified);

where the hold bill is generated on a mainframe computer operated by the outsourced entity, the tax charges on the hold bill are independently calculated by the outsourced entity, the tax charges on the hold bill are independently calculated by the outsourced entity, the local server is operated separately from the mainframe computer by the entity providing service, other than billing service, and the entity providing service, other than billing service, independently calculates the calculated tax results (Marchbanks discloses the method of generating invoices including an initial tax calculation which is then verified for accuracy and once verified then printed for final production, see column 4 lines 41+; The Examiner has used Official Notice to

outsource only the steps of generating the invoices including an initial tax calculation which is called a "hold bill"); and

where the calculated tax results match the tax charges on the hold bill, authorizing the outsourced entity, by the entity providing service, other than billing service, to send the hold bill as a customer bill to the customer (Marchbankes discloses that after the accuracy of the hold bills are verified the invoices are printed an distributed column 4 lines 49+; in this scenario when the recalculated value by the service provider is found to match the 3<sup>rd</sup> party's value the printing of the invoices is authorized and the 3rd party would send the bills to customers).

***Allowable Subject Matter***

3. Claims 1 and 3-10 are allowed.

***Response to Arguments***

4. Applicant's arguments filed 8/16/05 have been fully considered but they are not persuasive regarding claims 11-20.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the outsourcing of the recalculation of taxes, found in the second paragraph of page 8 of the Applicant's Response) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner has Modified Marchbanks by outsourcing the tax calculation used for generating the bills and the final distribution of the bills upon verification of the calculations by the service provider, where the service provider performs a recalculation of the tax in this verification. Examiner has used Official Notice to show that it would have been obvious to perform a recalculation to omit any errors in the data or calculation.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant has argued that the Examiner has used improper hindsight reasoning to combine Examiner's Official Notice of recalculation used for verification and the use of a worksheet for processing and comparing the tax data of the Marchbanks and Heindal references.

Examiner has provided documentation to show that recalculation, or a second distinct calculation, is a broadly accepted and general concept to eliminate errors. This would identify errors in both the data and the calculation performed. See definition of

recalculation stating that it means to calculate anew or to calculate again with a motivation being to eliminate errors.

Additionally Examiner has provided documentation, Microsoft Press Computer Dictionary page 511 definition of "worksheet", to show it is well known in the art of data processing to display database information in the form of a worksheet on a computer monitor to provide users the ability to view and manipulate data within the database.

In response to applicant's argument that it would not have been obvious to utilize an independent calculation, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571/272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elaine Gort  
Primary Examiner  
Art Unit 3627

April 17, 2006